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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,607	11/29/2005	Thomas Grafenauer	P28533	4105
7055 7590 04/08/2008 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191				
EXAMINER PLUMMER, ELIZABETH A				
ART UNIT		PAPER NUMBER		
3635				
NOTIFICATION DATE		DELIVERY MODE		
04/08/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com

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Office Action Summary

Application No.

10/550,607

Applicant(s)

GRAFENAUER ET AL.

Examiner

ELIZABETH A. PLUMMER

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date 10/26/2006, 03/15/2007, 06/08/2007
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Preliminary amendments to the specification received 07/13/2007 have been received and entered. Claims 1-20 are pending. This is a first Office action on the merits for application serial number 10/550,607 filed 11/29/2005.

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-5, 7-9, 14, and 17-20 rejected under 35 U.S.C. 102(b) as being anticipated by Martensson (WO 00/20705).

a. Regarding claim 1, Martensson discloses a device for connecting and locking building boards (1) comprising a top side and a bottom side having core made of wood (page 1, line 6) material and provided with a groove (4) on at least two opposite side edges comprising an insert (10) intended for locking purposes, wherein the insert can be inserted into the groove (4) of one of the side edges,

the boards being connected by substantially horizontal displacement one toward the other, wherein the insert is provide with at least on resilient lip (Fig. 7b, 7c, 7d) directed toward the top side or the bottom side.

b. Regarding claim 2, the insert has two resilient lips directed in the opposite direction (Fig. 7b,7c,7d).

c. Regarding claim 3, the insert is provide with resilient lips directed toward the bottom side (Fig. 7d).

d. Regarding claim 4, the resilient lip has a tip running obliquely to the top side and bottom sides, which tip, cooperates with an obliquely running edge (Fig. 7b,7c).

e. Regarding claim 5, the insert is plastic (page 8).

f. Regarding claim 7, the insert has a midway between the resilient lips which rests on a shoulder, running parallel to the bottom side of the bottom lip of the groove (Fig. 7c).

g. Regarding claim 8, when the building boards are mutually connected, the insert is essentially fully surrounded in its peripheral contour by the core material of the boards (Figs. 7a,7b,7c,7d).

h. Regarding claim 9, the angle of inclination between the obliquely running edge measures between 90 and 135 degrees (Fig. 7b,7c).

i. Regarding claim 14, the side edges of the insert taper outward (Fig. 7c).

j. Regarding claim 17, claim 17 is a product by process claim. The patentability of a product does not depend on its method of production. The

insert is inserted into a groove (abstract), and the final product does not vary regardless of whether or not the insert is inserted at a factory site.

k. Regarding claims 18 and 19, the insert can be permanently connected by glue (page 7).

l. Regarding claim 20, the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In this case, the board (1) has grooves (4).

4. Claims 1 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Martensson (US Patent 6,763,643).

a. Regarding claim 1, Martensson discloses a device for connecting and locking building boards (1) comprising a top side and a bottom side having core made of wood material and provided with a groove (4) on at least two opposite side edges comprising an insert (10) intended for locking purposes, wherein the insert can be inserted into the groove (4) of one of the side edges, the boards being connected by substantially horizontal displacement one toward the other, wherein the insert is provide with at least on resilient lip (Fig. 7b, 7c, 7d) directed toward the top side or the bottom side.

b. Regarding claim 13, the board is provided on one side with a tongue (22) pointing substantially in the transverse direction and on the other side edge with a groove (21) corresponding thereto (Fig. 8).

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 10-12 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martensson (WO 00/20705).

a. Regarding claims 10-12, Martensson discloses the invention as claimed except for specifying the thickness of the insert, the depth of penetration of the groove, or the flexural modulus of the plastic. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a structure within the claimed range, as it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or working ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

c. Regarding claims 15 and 16, Martensson discloses the invention as claimed except for the side edges of the insert being rounded or conical. However, it would have been a matter of obvious design choice to form the side edges as rounded or running conically, as such a modification would have involved a mere change in shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art. In re Dailey, 149 USPQ 47 (CCPA 1966).

Claim Rejections - 35 USC § 103

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martensson (WO 00/20705) in view of Riedi (US Patent 2,863,185). Regarding claim 6, Martensson discloses the invention as claimed except for the insert having at least one cavity. However, it is notoriously well known in the art that inserts can comprise a cavity. For example, Riedi teaches an insert (10) for connecting and locking boards (16), wherein the insert comprises at least one cavity (Fig. 1,2,3,4) in order to more easily deform to fit inside the grooves of the board. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Martensson to include at least one cavity, such as taught by Riedi, in order to make the device easier to install.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELIZABETH A. PLUMMER whose telephone number is (571)272-2246. The examiner can normally be reached on Monday through Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeanette E Chapman/
Primary Examiner, Art Unit 3633

/E. A. P./

Examiner, Art Unit 3635